

### **REMARKS/ARGUMENTS**

Reconsideration and allowance of the present application based on the following remarks are respectfully requested.

Claims 1, 4, 6-19, 23-26, and 29-30, have been amended. Claims 5, 6, 8 and 27-28 have been cancelled. New claims 31 and 32 have been added. Support for the amendments may be found throughout the specification. No new matter has been added as a consequence of these amendments.

For at least the following reasons, the claims are believed to be patentable over the cited references.

Claims 14-19 are rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement. Claim 12 is also rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. Claims 1-30 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

With regards to the **lack of upper limits** for lap shear adhesion and creep rupture adhesion, we would like to point out to the Examiner that it does not always make sense to have upper limits in certain test procedures. For example in the lap shear test the adhesive may be stronger than the actual wood it is being adhered to, and therefore when failure occurs it is failure within the wood and not the adhesive. Thus an upper limit would be an irrelevant property in relation to the adhesive. Similarly, the creep rupture test is continued until failure up to a certain time limit. The 1,000,000 second limit is chosen because the time limit is more than sufficient to establish certainty with regard to the that parameter for the tested sample. Applicants further note that the Example fully enables one of ordinary skill in the art to form the adhesives having set lower limits, such as "a lap shear adhesion value of greater than 6 MPa" or "a creep rupture adhesion value". In addition, it is not appreciated how the dependent claims could be said to be either indefinite and/or non-enabled as it is submitted that one of ordinary skill in the art could readily appreciate the metes and bounds of the claims and the manner of making such an adhesive without undue experimentation. Finally, the claims have been amended to address the Examiner's remaining formality concerns of the claims. Accordingly, it is submitted that the claims, as amended, are in full compliance with 35 U.S.C. §112,

first and second paragraphs, and a withdrawal of these rejections is courteously requested.

Claims 1 and 3-23 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 3,505,250 ("Saunders"). Claims 1 and 3-23 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 4,752,637 ("Israel"). Claims 1, 3-6, 9-11 and 13-23 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 4,933,232 ("Trout"). Claims 2 and 24-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Saunders. Claims 2 and 24-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel. Claims 2 and 24-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Trout. Claims 7 and 8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Trout in view of Israel. Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Trout in view of U.S. Patent 4,395,530 (Hammond). Applicants traverse these rejection for at least the following reasons.

Applicants note that the Examiner generally states that the cited references teach and/or suggest a moisture-curable adhesive. However, the Examiner fails to point out or provide a detailed description with any specificity as to the basis for this view. For example, the Examiner cited all of the following in Saunders:

A polyurethane plastic prepared from a reaction mixture containing an organic polyisocyanate, an organic compound containing at least two hydrogen atoms reactive with isocyanate groups and a mixture of polymerized fatty acids obtained by the dimerization of unsaturated fatty acids.  
(See, col. 1, lines 10-17, of Saunders)

...with the coating compositions of the invention such as, for example, wood, paper, porous plastics, such as,..  
(See, col. 9, lines 1-2, of Saunders)

For example, a dimer fatty acid can be obtained by combining two molecules of an unsaturated fatty acid, such as, for example, linoleic acid, in the presence of alkali, to form...  
(See, col. 3, lines 14-16, of Saunders)

The coating composition need not contain a solvent for all applications.  
(See, col. 9, lines 5-6, of Saunders)

Furthermore, it is submitted that Saunders discloses reacting dimer fatty acids with an organic polyisocyanate, but does not disclose reacting a polyester polyol containing dimer with a polyisocyanate. The materials produced by Saunders are

very different to those of the present invention, and will exhibit very different properties. Saunders does not disclose a moisture-curable adhesive.

Therefore, the Applicants submit that Saunders does not teach or suggest the moisture-curable adhesive of the present invention.

Similarly, Israel is directed to a binder for use in synthetic board. A particular problem solved is to minimise unwanted adhesion to the platens used in producing the board (column 1, lines 65-66), *i.e.*, to achieve release properties. The mention of dimer fatty acids are simply listed as one out of many possible starting materials for some of the components disclosed in Israel. Dimer fatty acids are not used in any of the Examples of Israel. Israel is directed to the use of aromatic polyesters. There is no disclosure of a polyol polyester containing 60 to 100% by weight of dimer fatty acid, and/or dimer fatty diol. There is no teaching of a moisture-curable adhesive.

Trout is also directed to a binder/release system for molded articles. Trout is concerned with the reaction between an isocyanate and a carboxylic acid. Trout does not disclose a polyol polyester formed from dimer. Example 1 shows that the presence of dimer fatty acids gives good release properties, and not adhesion properties.

Accordingly, Applicants submit that since there is no apparent teaching or suggestion in the cited references of a moisture-curable adhesive as averred by the Examiner that the rejections either be withdrawn or the Examiner state with specificity where these references teach a moisture-curable adhesive.


Therefore, all objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

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